

Application No. 10/516,419
Reply to Office Action of July 16, 2007

Docket No.: 60008US(49991)

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REMARKS/ARGUMENTS

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Claims 1-51 are pending in the instant application. Claims 17-51 have been canceled without prejudice. Accordingly, claims 1-16 will remain pending upon entry of the instant amendment. *No new matter has been added.*

Moreover, amendment and/or cancellation of the claims during pendency of the application are not to be construed as acquiescence to any of the objections/rejections set forth in any Office Action, and were done solely to expedite prosecution of the application. Applicants submit that claims were not added or amended during the prosecution of the instant application for reasons related to patentability. Applicants reserve the right to pursue the claims as originally filed, subsequently amended or added, or similar claims, in this or one or more subsequent patent applications.

Claims Rejections – 35 U.S.C. §103

Claims 1-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over each of Ross et al. (July 2002) and Lee et al. (WO 00/70334). Applicants respectfully disagree and traverse this rejection.

With regard to Ross et al., we respectfully remind the Examiner of the acknowledged and accepted claim for the benefit of priority of provisional application No. 60/385,018, filed on May 31, 2002. Applicants particularly assert that this date of priority clearly precedes Ross et al., which was published on July 12, 2002. As such, the rejection of claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over Ross et al. is inappropriate.

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With respect to Lee et al., the Office Action references page 5, lines 15-18, which recites that "the present invention is useful for the solubilization, analysis, separation, purification and/or characterization of large molecules." However, the Office Action suggests on page 4 that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the surfactant taught by each of Ross and Lee to analyze small molecules ***because the references teach digests of large molecules which are then analyzed where such digests form small molecules that are analyzed.*** It is shown that it is desirable to use the presently elected surfactant to improve the analysis of the digests ***[Emphasis Added].***

The Office Action attempts to use this suggestion as the sole support for the rejection of claims 1-16 as obvious in light of the cited art; concluding that there is only minimal distinction between "the references which teach the presently claimed method for 'samples' and show examples of digested proteins analyzed vs. the present claims which are directed to analysis of 'small molecules.'"

Applicants respectfully disagree. Applicants strenuously contend the accuracy of this statement, and ask that the Examiner explicitly indicate the passage to which he is referring. In fact, Applicants dispute that such passage exists and asserts that ***Lee et al. does not teach or suggest the analysis of digests of large molecules.*** Moreover, **nowhere** in Lee et al. is there any reference to the digestion of large molecules. In view of this lack of support, the Applicants further contend the validity of the conclusions reached by the Office Action, and respectfully ask for reconsideration in light of the comments made herein.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-16 under 35 U.S.C. §103(a), and favorable reconsideration.

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CONCLUSION

In view of the foregoing, reconsideration and withdrawal of all rejections, allowance of the instant application with all pending claims, and passage of the instant application to issuance are earnestly solicited. If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call Applicants' attorney at the telephone number below.

Applicants believe that there are no fees due with this response. However, if a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 04-1105 for any fee(s) due with this response.

Dated: October 16, 2007

Respectfully submitted,

By 

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